UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,875	09/25/2000	Jerry Freestone	NTL-3.2.133/3405 (12052SC	3055

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MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER
WON, MICHAEL YOUNG

ART UNIT	PAPER NUMBER
2455	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
09/668,875</td><td>Applicant(s)
FREESTONE ET AL.</td></tr>
<tr><td>Examiner
MICHAEL Y. WON</td><td>Art Unit
2455</td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 February 2010*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34,36-38,40-43 and 45* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34,36-38,40-43 and 45* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the Request for Continued Examination and

Amendment filed February 12, 2010.

2.   Claims 1, 8, 24, 40-43 and 45 have been amended and claims 35, 39, and

44 have been cancelled.

3.   Claims 1-34, 36-38, 40-43, and 45 have been examined and are pending

with this action.

Claim Rejections - 35 USC § 112

4.   Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention.

The examiner cannot determine how an email is sent from the sender with

an attachment from a recipient when the email has not initially been sent to the

recipient. There seems to be missing some essential steps or elements missing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1-10, 12-19, 21-31, 33-41, and 44-45 are rejected under 35

U.S.C. 102(e) as being anticipated by Ramesh et al. (US 6,801,931).

INDEPENDENT:

As per *claim 1*, Ramesh teaches an electronic message configured to be communicated between a sender's device and a recipient's device, the electronic message comprising:

a sound file attached to the electronic message (see col.2, lines 14-19: "and one or more attached documents or files of various types (e.g., word processor files, image files, audio files, spreadsheets, executable programs, or others)"); and,

a predetermined identifier attached to the electronic message and associated with the sound file, that both distinguishes said sound file from other files attached to the message and indicates a course of action to be taken by the recipient's device with said sound file (see col.2, lines 21-23: "set of basis vectors associated with a predetermined human speaker is additionally attached to the message payload");

based on said course of action indicated by said predetermined identifier,

said recipient's device is configured to selectively convert a content of the

electronic message form text to voice using one of said sound file and/or a locally

stored voice sample (see col.2, lines 35-37: "the recipient's communication

device renders the text to the recipient as audible speech"; col.3, lines 13-20 &

29-33: "synthesized as speech (250 and 260) using the attached set of basis

vectors as input to the speech synthesizer"; and col.3, lines 29-33);

the recipient's device is configured to selectively play said sound file

and/or said converted content of the electronic message (see col.3, lines 31-33:

"render the text as audible speech").

As per *claim 8*, Ramesh teaches a method for sending an electronic

message from a sender's device and a recipient's device, the method comprising

the steps of:

attaching a sound file to the electronic message (see col.2, lines 14-19:

"and one or more attached documents or files of various types (e.g., word

processor files, image files, audio files, spreadsheets, executable programs, or

others)"); and,

associating a predetermined identifier with said sound file and attaching

said sound file to the electronic message, said predetermined identifier

distinguishes said sound file from other files attached to the e-mail and indicates

a course of action to be taken by the recipient's device with said sound file (see

col.2, lines 21-23: "set of basis vectors associated with a predetermined human speaker is additionally attached to the message payload");

based on said course of action indicated by said predetermined identifier, selectively converting a content of the electronic message form text to voice using one of said sound file and/or a locally stored voice sample (see col.2, lines 35-37: "the recipient's communication device renders the text to the recipient as audible speech"; col.3, lines 13-20 & 29-33: "synthesized as speech (250 and 260) using the attached set of basis vectors as input to the speech synthesizer"; and col.3, lines 29-33);

selectively playing said sound file and/or said converted content of the electronic message (see col.3, lines 31-33: "render the text as audible speech").

As per *claim 24*, Ramesh teaches a method for announcing electronic messages comprising the steps of:

receiving an electronic message with an attached sound file (see col.2, lines 14-19: "and one or more attached documents or files of various types (e.g., word processor files, image files, audio files, spreadsheets, executable programs, or others)");

noting the presence of a predetermined identifier attached to the electronic message, wherein said predetermined identifier distinguishes said sound file from other files attached to the electronic message (see col.2, lines 21-23: "set of basis vectors associated with a predetermined human speaker is additionally attached to the message payload");

based on course of action indicated by said predetermined identifier,

selectively converting a content of the electronic message form text to voice

using one of said sound file and/or a locally stored voice sample (see col.2, lines

35-37: "the recipient's communication device renders the text to the recipient as

audible speech"; col.3, lines 13-20 & 29-33: "synthesized as speech (250 and

260) using the attached set of basis vectors as input to the speech synthesizer";

and col.3, lines 29-33); and

selectively playing said sound file and/or said converted content of the

electronic message in response to the noting of the predetermined identifier (see

col.3, lines 31-33: "render the text as audible speech").

DEPENDENT:

As per *claims 2-4, 14-16, and 26-28*, which respectively depend on

claims 1, 8, and 24, Ramesh further teaches wherein said sound file contains at

least one word in a computer-simulated voice and at least one word in a sender's

voice (see col.2, lines 37-39).

As per *claim 5*, which depends on claim 1, Ramesh further teaches

wherein the predetermined identifier is a specific file name associated with said

sound file (see 3, lines 53-54).

As per *claims 6, 17, and 29*, which respectively depend on claims 1, 8,

and 24, Ramesh further teaches wherein the predetermined identifier is an

information tag (see col.3, lines 54-61).

As per ***claims 7, 18, and 30***, which respectively depend on claims 6, 17, and 29, Ramesh further teaches wherein the information tag is embedded in a header of the electronic message (see col. 3, lines 51-53).

As per ***claim 9***, which depends on claim 8, Ramesh further teaches wherein said attaching is performed by the sender's device (see col.3, lines 9-11).

As per ***claim 10***, which depends on claim 8, Ramesh further teaches wherein said attaching is automatic (see col.2, lines 11-14).

As per ***claim 12***, which depends on claim 8, Ramesh further teaches wherein said attaching, is performed by an e-mail server (see col.4, lines 16-19).

As per ***claims 19 and 31***, which respectively depend on claims 18 and 30, Ramesh further teaches wherein the information tag, is embedded by the sender's device or by a sender computer (see col.43, lines 26-33 & 46-60 and col.44, lines 12-15).

As per ***claims 21 and 33***, which respectively depend on claims 18 and 30, Ramesh further teaches wherein the information tag, is embedded by an e-mail server (see claim 7 and 19 rejection above).

As per ***claim 22 and 34***, which respectively depend on claims 18 and 30, Ramesh further teaches wherein the information tag, is embedded by the recipient's device or by a recipient computer, respectively (see claim 13 and 19 rejection above).

As per *claim 23*, which depends on claim 18, Ramesh further teaches wherein said attaching, is selectively performed by a sending party (see claim 9 rejection above).

As per *claim 25*, which depends on claim 24, Ramesh teaches of further comprising receiving at least one more electronic message with an attached sound file and playing said at least one more sound file (see claim 1 rejection above).

As per *claim 36*, which depends on claim 24, Ramesh further teaches wherein said playing is performed at a recipient computer (see col.3, lines 31-33).

As per *claim 37*, which depends on claim 24, Ramesh further teaches wherein said playing is performed at recipient customer premise equipment (see col.3, lines 31-33)

As per *claim 38*, which depends on claim 24, Ramesh further teaches where said playing is performed at a recipient voice mail (see col.2, lines 2-6).

As per *claim 40*, which depends on claim 24, Ramesh further teaches where said converting is performed at an e-mail server (see col. 4, lines 16-19).

As per *claim 41*, which depends on claim 24, Ramesh further teaches where said converting is performed at a recipient computer (see col.2, lines 35-37).

As per *claim 45*, which depends on claim 24, Ramesh teaches of further comprising transferring said voice message to a voice mailbox (see col.2, lines 2-6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

6.   Claims 11, 20, 32, 42, and 43 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Ramesh et al. (US 6,801,931)in view of Agraharam et

al. (US 6,085,231 A).

As per **claims 11, 20, 32, and 42**, which respectively depend on claims 8,

18, 30, and 24, Ramesh does not explicitly teach where said attaching is

performed by an adjunct to the senders device.

Agraharam teaches of an adjunct (see col.3, lines 20-29: "email server

which is part of or an adjunct to the called party/subscriber's").

It would have been obvious to a person of ordinary skill in the art at the

time the invention was made to modify the system of Ramesh in view of

Agraharam by implementing an adjunct. One would be motivated to do so

because Ramesh suggests other embodiments are possible without departing

from essential character of the invention (see col.5, lines 25-30).

As per **claim 43**, which depends on claim 24, Ramesh does not explicitly

teach wherein said converting is performed at a voice messaging system.

Agraharam teaches wherein said converting is performed at a voice messaging system (see Fig.2, #202 & #206 and col.4, lines 7-17).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Ramesh in view of Agraharam so that the converting is performed at a voice messaging system. One would be motivated to do so because Ramesh teaches that other form of synthesis methods can be employed (see col.2, lines 56-62).

Response to Arguments

7.   Applicant's arguments with respect to claims 1-34, 36-38, 40-43, and 45 have been considered but are moot in view of the new ground(s) of rejection. Based on the change in scope of the invention per the amendment filed February 12, 2010, Ramesh et al. (US 6,801,931) has been cited to teach the invention. Agraharam et al. (US 6,085,231 A) remains as a secondary which teaches the missing limitations of claim 11, 20, 32, 42, and 43.

Conclusion

8.   For the reasons above, claims 1-34, 36-38, 40-43, and 45 has been rejected and remain pending.

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL Y. WON whose telephone number is (571)272-3993. The examiner can normally be reached on M-Th: 9AM-7PM.

If attempts to reach the examiner by telephone are unsuccessful, the
examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax
phone number for the organization where this application or proceeding is
assigned is 571-273-8300.

Information regarding the status of an application may be obtained from
the Patent Application Information Retrieval (PAIR) system. Status information
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Representative or access to the automated information system, call 800-786-
9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Won/

Primary Examiner

AU 2455

March 8, 2010